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In re Application of	:	
Masatomi et al.	:	
Application No.: 10/562,656	:	
PCT No.: PCT/JP04/09403	:	
Int. Filing Date: 25 June 2004	:	DECISION
Priority Date: 27 June 2003	:	
Attorney Docket No.: 71,051-026	:	
For: Coating Composition	:	

This is in response to the "Petition For Revival Of Abandoned Application" filed on 15 August 2007.

### DISCUSSION

In a Decision mailed on 11 June 2007, the declaration filed on 24 November 2006 was reviewed, and treated as follows:

Inspection of the declaration documents filed on 24 November 2006 reveals that one document nominates and is executed by Toru Masatomi and Motoshi Sasaki, while the other declaration document nominates and is executed by Hideki Kobayashi. Neither document nominates the entire inventive entity shown on the published international application. Applicants' attention is drawn to MPEP 201.03, which explains in part that

**While each inventor need not execute the same declaration, each oath or declaration executed must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.**

Since neither of the declaration documents filed on 24 November 2006 "contain[s] a complete listing of all inventors," they are not acceptable for purposes of compliance with 37 CFR 1.497(a) and (b). Therefore, the Notice of Acceptance mailed on 09 April 2007 was defective, and it is hereby VACATED.

Inspection of the declaration filed on 01 May 2006 reveals that inventors Masatomi and Sasaki are nominated on one page "3 of 3," while inventor Kobayashi is nominated on a separate page "3 of 3." As such, it is not clear from inspection of the declaration itself whether each inventor executed a complete declaration document nominating the entire inventive entity.

The Decision further stated that

Since the defective declaration filed on 24 November 2006 was in response to a Notification of Defective Response (Form PCT/DO/EO/916) which set a non-extendable time limit in which to perfect the declaration requirement, and since said time period has now expired, this application stands **ABANDONED** with respect to the national stage in the United States. Applicants may wish to consider filing a petition under 37 CFR 1.137(b) in the event that revival is sought.

In response, applicants filed the instant petitions under 37 CFR 1.137(a) and 1.137(b).

*Petition Under 37 CFR 1.137(a)*

37 CFR 1.137(a) provides that

(a) *Unavoidable*. If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

With regard to **requirement (1)**, petitioner has filed the required reply in the form of a declaration of the inventors which complies with the requirements of 37 CFR 1.497(a) and (b).

Concerning **requirement (2)**, the \$500.00 petition fee is being charged to Deposit Account No. 08-2789, as authorized by the instant petition.

With respect to **requirement (3)**, petitioner argues, in essence, that applicants relied upon the 09 April 2007 Notice of Acceptance (and filing receipt) as indicating that the USPTO had accepted the declaration filed on 24 November 2006 in response to the Notification of Missing Requirements mailed on 09 November 2006, and that the delay in filing a further oath or declaration document, acceptable under 37 CFR 1.497(a) and

(b), was unavoidable because applicants were not provided with further notification. Specifically, petitioner suggests that

If given notice of any issues with the Declaration filed on November 24, 2006, such as by receiving a Second Notification of Defective Response, the Applicants could have filed another timely response addressing any new issues presented by upon investigation of the Declaration. However, the Applicants were given no such opportunity prior to the present application going abandoned.

Petitioner is respectfully advised that the mailing of a Notification of Defective Response, as occurred in this case, is a mechanism intended to offer applicants an opportunity to cure a defective or deficient response. Since a Notification of Defective Response is mailed after applicant has already been given notice of a missing requirement (e.g., via a Notification of Missing Requirements (Form PCT/DO/EO/905)), no new period for response is given; rather, applicant is required to respond within the existing extendable period for response, or within a non-extendable one-month time limit in which to perfect the response, whichever expires later. A further Notification of Defective Response is, by policy, not provided. Therefore, in the present case, petitioner was required to furnish an acceptable oath or declaration no later than 09 December 2006. Applicants' response was filed on 24 November 2006, but failed to perfect the missing requirement for an oath or declaration compliant with 37 CFR 1.497(a) and (b). Even assuming *arguendo* that the USPTO had immediately analyzed the declaration filed on 24 November 2006 and discovered its deficiency at that time, applicants' last opportunity to file an acceptable oath or declaration would have ended on 09 December 2006, the end of the period for response set by the Notification of Defective Response. Meanwhile, the Notice of Acceptance (Form PCT/DO/EO/903) applicants seek to rely upon as an indication that no further response was required was not mailed until 09 April 2007, four months after the latest date on which an acceptable oath or declaration could have been filed to prevent abandonment. In this sense, the mailing of the Notice of Acceptance in no way prejudiced applicants.

It should also be observed that the propriety of the Notice of Acceptance mailed on 09 April 2007 was not reviewed by the Office of PCT Legal Administration until 11 June 2007, at which time it was vacated as having been mailed in error. The fact that this Office did not review the procedural issues in this case until 11 June 2007 did not and does not relieve applicants of their duty to provide an appropriate reply to the Notification of Defective Response, though the time period for doing so had expired 6 months prior.

For these reasons, it would not be appropriate to conclude on the basis of the present record that requirement (3) has been satisfied.

Regarding **requirement (4)**, no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

*Petition Under 37 CFR 1.137(b)*

Petitioner requests relief pursuant to 37 CFR 1.137(b) in the event that relief is not granted under 37 CFR 1.137(a). A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding **requirement (1)**, the "required reply" has been provided, as described above.

Regarding **requirement (2)**, the \$1500.00 petition fee is being charged to Deposit Account No. 08-2789, as authorized by the instant petition.

Regarding **requirement (3)**, the petition states that "the entire delay in filing the required reply from the due date for the required reply until the filing of the subject petition under 37 CFR § 1.137(b) was unintentional." This is being construed as a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement is not correct. Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding **requirement (4)**, no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

**DECISION**

The petition under 37 CFR 1.137(a) is **DISMISSED**, without prejudice.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **15 August 2007**.



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